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| 09/596,806      | 06/19/2000  | Harry J. Buncke      | 540P                | 4594             |

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Thomas M Freiburger  
P.O. BOX 1026  
TIBURON, CA 94920

EXAMINER

ODLAND, KATHRYN P

| ART UNIT | PAPER NUMBER |
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3743

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Please find below and/or attached an Office communication concerning this application or proceeding.



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**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

Application Number: 09/596,806  
Filing Date: June 19, 2000  
Appellant(s): BUNCKE, HARRY J.

**MAILED**  
**SEP 23 2004**  
**GROUP 3700**

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Thomas Freiburger  
For Appellant

**EXAMINER'S ANSWER**

This is in response to the appeal brief filed June 21, 2004.

**(1) *Real Party in Interest***

A statement identifying the real party in interest is contained in the brief.

**(2) *Related Appeals and Interferences***

A statement identifying the related appeals and interferences, which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

**(3) *Status of Claims***

The statement of the status of the claims contained in the brief is correct.

**(4) *Status of Amendments After Final***

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

**(5) *Summary of Invention***

The summary of invention contained in the brief is deficient because it contains subject matter not presented in the original application, i.e. new matter. Applicant recites, "The flexible cable is not simply something that can be bent or manipulated, it is defined as being sufficiently flexible as to avoid movement of the clip applicator's tip when the remote actuator is engaged and moved to apply the force." This definition of flexible is not in the original application. In fact, there is no definition of the term "sufficiently flexible."

**(6) *Issues***

The appellant's statement of the issues in the brief is correct.

**(7) Grouping of Claims**

Appellant's brief includes a statement that no claims stand or fall together and provides reasons as set forth in 37 CFR 1.192(c)(7) and (c)(8).

**(8) Claims Appealed**

The copy of the appealed claims contained in the Appendix to the brief is correct.

**(9) Prior Art of Record**

4,485,817                                      Swiggett                                      12-1984

Buncke, Prior art disclosed in the current application (Figures 1-4)

**(10) Grounds of Rejection**

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1-11 are rejected under 35 U.S.C. 103(a). This rejection is set forth in a prior Office Action, mailed on January 13, 2004.

**(11) Response to Argument**

Appellant argues, "Basically, the entire weight of the examiner's argument hangs on the premise that the Swiggett device could be considered to have a handle at the clip-applying end of the device, i.e. presumably portion 34 of the applicator end 16 in Swiggett." The examiner respectfully disagrees and it appears that appellant's arguments are not commensurate with the scope of the claim language. For example, appellant is directed to claims 1, 3 and 9, which recite the limitation, "a handle suitable for gripping in the hand of a surgeon." Surely the portion 34, etc. of Swiggett is **suitable for gripping**. Appellant has not provided any structure that would preclude the device of Swiggett from suitable gripping.

Appellant further argues, Swiggett teaches a device for applying clips, as does the appellant, but for a different purpose. The reference does not seek to avoid movement induced by the surgeon's hand, translating through the length of the device to the clip applying tip." However, appellant is directed to the current application specification which recites, "The remote actuation provided by the invention also solves the problem of narrow access... It is this among the objects of the invention to make far more effective and reliable the use of a surgical clip applier for closing tissue separation sites, by modifying the clip applier [prior art clip applier] to receive its actuating force through a flexible, remotely operated device..." It is clearly discussed in the specification that a purpose of the device is for remote operation in deep inaccessible areas, as discussed in the Summary of the Invention. With that in mind, appellant is then directed to that discussed in Swiggett. There is a clear teaching, as stated in the abstract, of a surgical stapler with an actuator section remote from the stapling section and a longitudinally flexible shaft to generate a force to staple. Column 1, lines 13-16 discuss a surgical stapler and column 2, lines 1-6 discuss "a longitudinally flexible instrument for applying surgical fasteners to tissue." The purpose is clearly remote actuation not unlike that disclosed in the current application. Therefore, there is a common purpose. Further, the modification would necessarily yield isolation movement via the surgeon's hand. Nonetheless, appellant is directed to *In re Wright*, U.S. Court of Appeals Federal Circuit (6 USPQ2d 1959) Decided May 24, 1988 where it is discussed that the modification does not necessarily need to be made for the same reasons. "Commissioner on appeal argued that the Bishop and Vaida references

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presented, in combination, a prima facie case of unpatentability, stating: claimed invention may be unpatentable if it would have been obvious for reasons suggested by the prior art, even though those reasons may be different from the reasons relied upon by the inventor and may result in a different advantage." Moreover, appellant is directed to section 2144 of the M.P.E.P., which states:

RATIONALE MAY BE IN A REFERENCE, OR REASONED FROM  
COMMON KNOWLEDGE IN THE ART, SCIENTIFIC PRINCIPLES,  
ART-RECOGNIZED EQUIVALENTS, OR LEGAL PRECEDENT

The rationale to modify or combine the prior art does not have to be expressly stated in the prior art; the rationale may be expressly or impliedly contained in the prior art or it may be reasoned from knowledge generally available to one of ordinary skill in the art, established scientific principles, or legal precedent established by prior case law

Appellant also argues, "There are other specific assumptions of the examiner which are clearly wrong. She states that the "cable sheath and internal bracket are sufficiently flexible so as to avoid movement of the tip when the hand operable actuator is moved to apply the pushing force." However, appellant has not defined sufficiently flexible in the current application specification such that it would preclude that of Swiggett to be considered "sufficiently flexible." "Sufficiently flexible" is a relative term and a base for comparison has not been established. Appellant states, "This is not what is defined in the current claims, the flexibility defined in the claims essentially recited a flimsy flexible force-transmitting device..." However, this argument is not

commensurate with the scope of the claim. Nowhere in the claims or specification is "flimsy flexible" discussed or supported.

Moreover, appellant agrees, "Yes, it is possible that the applicator end of the Swiggett's device could be held in the hand of the surgeon, but this is not what is taught in Swiggett and is contrary to the purpose of Swiggett." However, the modification is not contrary to the purpose of Swiggett since Swiggett also discloses remote actuation and it is a well known goal in the medical art to have remote actuation for numerous purposes and it would be obvious to one with ordinary skill in the art to modify the prior art device by Swiggett for the purpose of remote application a goal of both devices.

Regarding the dependent claim rejections, the modification would necessarily yield that claimed and appellant has not provided sound arguments to the contrary.

Appellant attempts to rebut the method claim rejections by attacking the examiner rather than providing solid arguments as to the flaws in the examiner's position. The appellant recites, "The examiner goes far afield at page 7 where she states that the method (of claims 9-11) would be obvious as in the apparatus rejections." However, the examiner respectfully disagrees with this statement, since the combination of the prior art device with a remote actuation via the cable as taught by Swiggett would necessarily yield the method claims. Then appellant states, "There are many serious flaws in the examiner's arguments regarding these claims, but this is the worst of them... She clearly is pulling herself up by her bootstraps here, with an impossible leap on top of a flawed argument, she appears not to have read claim 9, not to have read the attorney's arguments, and not to have compared claim 9 to the prior

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art." The examiner respectfully asserts that the method would be inherently obvious when modifying the prior art device. The method of using the prior art device is well known in the art and given the remote actuation, as taught by Swiggett, the method of use in modifying the well-known and used prior art device would necessarily yield that disclosed in the method claim. Modifying the known prior art clip applicator to include remote actuation would necessarily yield a mode of operation that is commensurate with that claimed in the method claims and Swiggett was relied upon for the teaching of remote actuation via a flexible cable.


For the above reasons, it is believed that the rejections should be sustained.


Respectfully submitted,

Kathryn Odland  
September 20, 2004

Conferees  
Henry Bennett  
Denise Esquivel

Thomas M Freiburger  
25th Floor  
650 California Street  
San Francisco, CA 94108

  
Henry Bennett  
Supervisory Patent Examiner  
Group 3700

  
DENISE L. ESQUIVEL  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 3700